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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,801	08/17/2000	G. John Stanton	265.0023 0101	5388

7590 07/03/2003

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EXAMINER
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NICHOLS, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 07/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/641,801

Applicant(s)

STANTON ET AL.

Examiner

Christopher Nichols, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11 and 13-35 is/are pending in the application.
- 4a) Of the above claim(s) 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11 and 13-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 16 19.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application, Amendments, and/or Claims***

1. **As discussed in the interviews (Paper No. 16 and Paper No. 19) concerning the instant application, prosecution is hereby reopened.**
2. Claims 1-4, 6-9, 11, and 13-35 are under examination.
3. Claims 37-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.
4. The rejection of claims 1-3 and 6-9 under 35 U.S.C. §102(b) as set forth at ¶10 pp. 6-7 in the previous Office Action (Paper No. 10, 4 September 2002), the rejection of claims 11 and 13-19 under 35 U.S.C. §102(b) as set forth at ¶11 pp. 7 in the previous Office Action (Paper No. 10, 4 September 2002), and the rejection of claims 20-35 under 35 U.S.C. §102(b) as set forth at ¶12 pp. 8 in the previous Office Action (Paper No. 10, 4 September 2002) are *maintained*. Taking the interview discussions (Paper No. 16 and Paper No. 19) of the instant application into consideration, the aforementioned rejections are maintained due to the open claim language “comprises” which reads on full-length colostrinin. However, it is noted that Applicant can obviate the aforementioned rejections by amending the claims to have closed claim language such as “consisting of”.

### ***Claim Objections***

5. Claims 1-4, 6-9, 11, and 13-35 are objected to because of the following informalities: recite non-elected SEQ ID NO's. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims **1-3, 6-9, 11, and 13-35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what the metes and bounds of constitutes "structural similarity". Applicant can obviate this rejection by amending the claims to read "sequence homology" instead of "structural similarity".

***Obvious-Type Non-Statutory Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims **1-4, 6-9, 11, and 13-35** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6500798 B1 (31 December 2002) Stanton *et al.* Although the conflicting claims are not

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identical, they are not patentably distinct from each other because US 6500798 teaches the administration of SEQ ID NO: 1 to a human (claims 1-22).

8. While not practicing the preamble of the instant claims, it has been established by the courts that a product inherently possesses characteristics of that product (i.e. including the amino acid sequence of a protein). See, e.g., *Ex parte Gray*, 10 USPQ 2d; *In re Best*, 195 USPQ 430).

In addition,

“the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Accordingly, since the issue in the present appeal is whether the prior art factor is identified or patently indistinct from that of the material on appeal, appellants have the burden of showing that inherency is not involved”. *Ex parte Gray*, 10 USPQ 2d 1922 (1989); *In re Best*, 195 USPQ 430 (CCPA 1976).

9. Moreover, when the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*., 227 USPQ 964, 966 (Fed. Cir. 1985); *In re Marosi*, 218 USPQ 289, 292-293 (Fed. Cir. 1983). Lastly it is noted that the courts have held that when the prior art product reasonable appears to be the same as that claimed, but differs by process in which it is produced, a rejection of this nature is eminently fair and the burden is upon the appellants to prove, by comparative evidence, a patentable difference (*In re Brown*, 173 USPQ 685).

### ***Summary***

10. Claims 1-3, 6-9, 11, and 13-35 are hereby rejected.

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11. The following art and patents were found by the Examiner during the art search and are here made of note:

- a. US 6410058 B2 (25 June 2002) Gohlke *et al.*
- b. Kruzel *et al.* (December 2001) "Towards an Understanding of Biological Role of Colonstrinin Peptides." Journal of Molecular Neuroscience **17**(3): 379-389

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### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher James Nichols, Ph.D.** whose telephone number is 703-305-3955. The examiner can normally be reached on Monday through Friday, 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gary Kunz, Ph.D.** can be reached on 703-308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications. The fax phone numbers for the customer service center is 703-872-9305

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

CJN  
July 2, 2003

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**